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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
2541

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Signature

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name Lawrence H. AaronsonApplication Number
10/677,784Filed
October 2, 2003First Named Inventor
David B. PalanArt Unit
2617Examiner
M. Santiago Cordero

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.Registration number 35,818☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

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July 27, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Docket No. 2541)

In re Application of:

David B. Palan

Serial No. 10/677,784

Filed: October 2, 2003

For: METHOD AND SYSTEM FOR
DELIVERING WIRELESS
TELEPHONE SERVICE TO
CUSTOMER PREMISES VIA
LOCAL LOOP TELEPHONE LINES

Group Art Unit 2617

Examiner: M. Santiago Cordero

Confirmation No. 9577

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313

REASONS FOR REVIEW OF FINAL REJECTION

Applicant requests review of the final rejection mailed March 27, 2006, because the Examiner has not set forth a sufficient basis for rejecting any of the claims. In particular, the Examiner has not pointed to any teachings in the art that disclose or suggest the combination of elements recited in the claims.

Presently pending are claims 1-8, 10, 14-32, and 34, of which claims 1, 22, 28, and 31 are independent.¹ The Examiner indicated in the Advisory action that Applicant's latest claim amendments will be entered for purposes of appeal, and the Examiner confirmed that plan in a brief voice mail message to the undersigned on July 19, 2006.

The Examiner rejected claim 1 on grounds of alleged anticipation by WO/03024071. This rejection is clearly erroneous at a minimum because Kim fails to teach providing the interface arrangement at a telephone company central office that includes a telephone company

¹ In the Response After Final, Applicant inadvertently referred to claim 22 as depending from claim 1.

switch, where local loop telephone lines normally extend to the telephone company switch, and where the telephone company switch provides connectivity to a transport network, as recited in claim 1. These claim limitations are not mere surplus language of claim 1; yet the Examiner appears to have read the elements out of the claim, concluding that they are a mere "fair characterization." The arrangement of the location at which the claimed interface arrangement is provided is specifically recited and defined in claim 1, and providing the interface at that specifically defined location clearly distinguishes over Kim.

To help the panel understand the arrangement of claim 1, Applicant requests the panel to see Figures 1 and 3 of the application. As illustrated by example in Figure 1, and as recited specifically in claim 1, local loop telephone lines 22, 24 normally extend between multiple customer premises 14, 16 and a telephone company switch 20 at a telephone company central office 12, where the telephone company switch provides connectivity with a transport network such as the PSTN 30. As illustrated by example in Figure 3, claim 1 then recites that the local loop telephone lines are interfaced with wireless transceivers 50, 52 *at that telephone company central office* between the telephone company switch and the customer premises (e.g., that each line normally extending to the switch can be instead connected with a wireless transceiver), so that the wireless transceivers 50, 52 can wirelessly connect the local loop telephone lines 22, 24 to the transport network 30 via a wireless access network 54.

This claim language thus makes clear that the wireless interfacing function *occurs at the telephone company central office that includes the telephone company switch*, and that the interfacing occurs at a point between the telephone company switch and the customer premises. Kim does not teach this claimed arrangement, either expressly or inherently, and thus Kim does not anticipate claim 1.

As explained in the Response After Final, Kim teaches a system 100 that includes (i) wireless communication modules 10a-10n, (ii) connectors 30 for wired telephone lines, and (iii)

logic 21, 23, 24, 25 interfacing the wireless communication modules with the wired telephone lines. With Kim's arrangement, a wired telephone can place a PSTN call via the interface system 21, 23, 24, 25, over a wireless link to a radio access network (RAN) 300 that connects with the PSTN. Likewise, Kim allows a call from the PSTN to be set up by the RAN 300 to a wireless communication module, with the interface system 21, 23, 24, 25 in turn extending the call via a wired telephone line to a wired telephone. Kim explains that the interface arrangement is usable where wired PSTN connectivity does not exist – such as in a campsite or in developing countries. (See Kim's closing paragraphs.)

Kim fails to teach providing the claimed interface arrangement at a telephone company central office that includes a telephone company switch, where the local loop telephones normally extend to the telephone company switch, and where the telephone company switch provides connectivity to the transport network, as specifically set forth in claim 1.

In rejecting claim 1, the Examiner asserted that Kim teaches carrying out the interfacing function at a telephone company central office, citing Figure 1 of Kim in support of this proposition. Further, the Examiner asserted that the term "telephone company central office" in Applicant's claim is broad enough to read on Kim's element 100. In particular the Examiner concluded "Kim's element 100 is part of a telephone company and is performing as a central office because communications are controlled and routed through element 100." Applicant submits that this reasoning by the Examiner is in error and that the rejection is clearly improper.

By arguing that Kim's interface system "performs as a central office" in that it connects/routes calls, the Examiner has improperly disregarded some of Applicant's claim language. In particular, Applicant's claim recites that the telephone company central office includes a telephone company switch to which the local loop telephone lines normally extend and that provides connectivity with the transport network, and Applicant's claim recites the function of interfacing the local loop telephone lines with wireless transceivers between the

telephone company switch and the customer premises. Kim fails to teach such an arrangement, and the Examiner has not pointed to any teaching in Kim of (i) a telephone company central office including a telephone company switch to which local loop telephone lines normally extend and that provides connectivity with the transport network, or (ii) interfacing the local loop telephone lines with wireless transceivers between the telephone company switch and the customer premises.

Kim's interface system provides telephone connectivity, but that does not mean that Kim's interface system is provided at a telephone company central office of the type specifically defined in Applicant's claims – in particular at a central office that includes the telephone company switch to which the local loop telephone lines normally extend and that provides connectivity with the transport network. Kim does not expressly teach providing Kim's interface system at such a telephone company central office, and Kim does not inherently teach doing so, because doing so does not necessarily follow from any disclosure in Kim.

Indeed, a plain reading of Kim makes clear that Kim's interface system is intended for use specifically where no such transport network connectivity exists already, such as in a campsite or developing country. Thus, even with use of impermissible hindsight, it would be illogical to conclude that Kim teaches providing its interface system in a telephone company central office including a telephone company switch to which local loop telephone lines normally extend and that provides connectivity with a transport network. Given Kim's clear disclosure, there would be no need for Kim's invention in a place where such PTSN connectivity existed already.

In the advisory action, the Examiner attempted to rebut Applicant's arguments by asserting that it is conventional to include a switch in a central office and to have local loop telephone lines extend to such a switch. True, those concepts are known. Yet Applicant does not claim these concepts. Rather, Applicant specifically claims carrying out the inventive

interface function *at a telephone company central office that includes such a switch arrangement*. Adding the inventive interface arrangement at such a conventionally arranged central office is the very point of the present invention, and Kim simply fails to suggest doing so.

Kim is equally deficient with respect to independent claims 28 and 34, both of which also expressly recite that the claimed interface arrangement is provided at a telephone company central office that includes a switch operable to provide connectivity with the transport network. Thus, Kim fails to anticipate claims 1, 28, and 34.

Still further, for at least the same reason, Kim fails to teach the combination of elements set forth in claim 22, including providing the interface function at a central office that includes a switch for connecting local loop telephone lines with a central office. And the Examiner has not pointed to anything in the secondary Wu reference that makes up for this clear deficiency. Rather, the Examiner merely asserted in essence that Wu teaches a landline carrier and a wireless carrier, and the Examiner concluded that it would be a good idea to combine those arrangements together to achieve Applicant's invention. However, the Examiner did not cite to any objective art suggesting such a combination, as M.P.E.P. § 2143 requires. Thus, the Examiner has not made out a *prima facie* case of obviousness of claim 22.

For these reasons, the Examiner has clearly erred in rejecting independent claims 1, 22, 28, and 34, and thus the Examiner has also clearly erred in rejecting the dependent claims as well. Accordingly, Applicant respectfully requests the panel to withdraw the rejections of all of the pending claims, and to direct that a Notice of Allowance be mailed.

Respectfully submitted,
McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP

Dated: July 27, 2006

By: 

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